

REMARKS

Claims 126-149, 151-166, 168-172, 174-176 and 202-204 are presented for examination.

Claims 126, 139, 154, 165, and 171 are amended.

Applicants and their undersigned attorney gratefully acknowledges the clear suggestion made by the Examiner in the Advisory Action dated April 17, 2007 to amend claim 126 to affirmatively recite a distinction from Kerner, and have adopted that suggestion.

Claims 154-164 remain rejected. Applicants propose to amend claim 154 to recite language which parallels claim 136, that “said processor controls said mapping system to map the gemstone”, conformed to the claim 154 antecedent basis, and thus recite “said computer means being capable of ~~manipulating~~ controlling both said apparatus to optically generate a map of a diamond and said attachment to mark the diamond with the predetermined pattern.” (Note that claim 126 recites: “a processor for **controlling** the marking system and alignment system to bring the axis and the gemstone to a succession of marking positions to define the predetermined pattern...”). It is respectfully submitted that this amendment does not raise new issues in the application nor insert new matter. While the claim does not expressly encompass the mapping apparatus per se, it does encompass the computer for controlling the mapping apparatus and the marking attachment, and thus, it is respectfully submitted, does affirmatively recite a patentable difference from Kerner under the two way test. It is therefore respectfully submitted that these amendments render all claims allowable.

The relevant claims of Kerner, US 20020030039, claims 1 and 5, read:

1. A diamond marking attachment for a 3D diamond mapping apparatus capable of generating a map of a diamond whose surface is to be marked with a predetermined pattern and of determining a succession of marking points representing said pattern, said attachment comprising: a laser source with its associated focusing optics for emitting a focused laser beam along an optical path; marking position establishing system to move the optical path relative to the diamond and to thereby bring them both in a marking

position, and computer means to manipulate said marking position establishing system to bring the laser beam and the diamond into said marking position successively in each of said marking points.

5. An attachment according to claim 4, further comprising a base with said laser source and said beam orientation system mounted therein, the base having support surfaces for mounting thereon said diamond mapping apparatus, said computer means being capable of manipulating both said apparatus and said attachment.

In contrast, claim 154 of the present application (as currently amended, marked to show differences from Kerner) recites:

154. A diamond marking attachment for a 3D optical diamond mapping apparatus capable of generating a map of a diamond whose surface is to be marked with a predetermined pattern and of determining a succession of marking points representing said pattern, said attachment comprising:

a laser source with its associated focusing optics for emitting a focused laser beam along an optical path;

marking position establishing system to move the optical path relative to the diamond and to thereby bring them both in a marking position, and

computer means to manipulate said marking position establishing system to bring the laser beam and the diamond into said marking position successively in each of said marking points, further comprising a base with said laser source and said beam orientation system mounted therein, the base having support surfaces for mounting thereon said optical diamond mapping apparatus, said computer means being capable of ~~manipulating~~ controlling both said apparatus to optically generate a map of a diamond and said attachment to mark the diamond with the predetermined pattern.

This amendment is substantive, in that the manipulation of the apparatus and attachment by the computer means in accordance with claim 5 of Kerner is patentably distinct from the controlling in accordance with the present claim 154.

The independent claims are each amended to recite that the mapping system is “optical”, that is, the mapping system employs optical methods for mapping the diamond. It is noted that the art recognizes other substantial non-equivalent alternates for this function, such as physical means (e.g., atomic force microscopy, mechanical gages), and therefore the amendment is substantive. It is further believed that these amended claims distinguish Kerner, in a manner not addressed by any of the claims of Kerner, and are therefore patentable thereover.

It is further respectfully submitted that these amendments obviate the need for declaration of interference under 35 U.S.C. § 135, and to the extent that the claim amendments are entered and the application rendered allowable thereby, applicants' request for declaration of interference is withdrawn, without prejudice to applicants' right to readdress these issues in future prosecution. The presently claimed invention is not "... the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application"

It is therefore respectfully submitted that claims are therefore allowable, and a Notice of Allowance is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven M. Hoffberg", with a stylized, flowing script.

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